REMARKS

Claim 6 is now pending in this application. By this amendment, claims 1-5 are canceled without prejudice. No new matter has been added. Favorable reconsideration of the application in light of the foregoing amendments and following comments is respectfully solicited. Entry of the foregoing amendment is appropriate under 37 C.F.R. § 1.116(b)(1), as it is "[a]n amendment . . . made canceling claims."

Remarks in Section 1 of the Office Action

On page 7 of the Response filed on February 13, 2009, Applicants explained that "Claim 6 is an English language translation of allowed claim 1 of Japanese Patent No. 3,915,705, which issued on May 16, 2007 from Japanese Patent App. No. 2003-021854, to which this application claims priority." Listing an apparently machine-generated translation of claim 1 as published in Japanese Patent App. Pub. No. 2003-265459 – rather than a translation of *issued* claim 1 of Japanese Patent No. 3,915,705 cited by the Applicants – page 3 of the Office Action requests that Applicants "[p]lease provide document to substantiate claim 1 [of Japanese Patent No. 3,915,705]."

Applicants respectfully note that the listing provided on pages 2-3 of the Office Action is (1) based on the application, rather than the issued patent; and (2) appears to be a machine-generated translation. Where, as was the case here with Japanese Patent App. No. 2003-021854, a claim is amended during the course of prosecution, there will be differences between claims listed in the application and the issued claims. Accordingly, there are differences between the listing presented on pages 2-3 of the Office Action and pending claim 6. It is noted that through the Industrial Property Digital Library (IPDL) available online at

http://www.ipdl.inpit.go.jp/homepg_e.ipdl, a crude machine-generated English language translation of claim 1 as issued in Japanese Patent No. 3,915,705, which illustrates the amendments made to the claim, is available for the Examiner's consideration. Of course, as the IPDL-provided translation is machine-generated, it will not be identical to pending claim 6.

In response to the request to "substantiate claim 1," accompanying this Response is a declaration that claim 6 of this application is a true English translation of claim 1 as issued in Japanese Patent No. 3,915,705. Additionally, Applicants note that support for claim 6 is found, for example, in paragraphs [0035]-[0054] of U.S. Patent App. Pub. No. 2006/0165378 corresponding to this application, and FIGS. 1 and 5.

Rejections Under 35 U.S.C. § 103(a)

In section 3 of the Office Action, claims 1 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,345,430 (Moe) in view of U.S. Patent No. 6,115,202 (Yoshida) and U.S. Patent No. 4,618,890 (Kouyama). In section 4 of the Office Action, claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Moe in view of Yoshida, Kouyama, and JP Patent App. Pub. No. H11-205725 (Naoya). In section 5 of the Office Action, claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Moe in view of Yoshida, Kouyama, and U.S. Patent No. 5,758,013 (Kizu). In section 6 of the Office Action, claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Moe in view of Yoshida, Kouyama, and JP Patent App. Pub. No. H04-252484 (Toyoshima). In section 7 of the Office Action, claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Moe in view of Yoshida, Kouyama, Naoya, and Toyoshima. Applicants respectfully traverse.

As noted above, claims 1-5 have been canceled without prejudice. Thus, the rejections set forth in sections 3-6 of the Office Action are moot.

Claim 6 recites, *inter alia*,

> reproducing a time code which is included in an auxiliary information recorded previously and located immediately before a recording starting point where said recording/reproduction section starts to record next on said recording medium to maintain as a recorded time code;
> **generating a regeneration value obtained from a time code to which one frame time is added to said recorded time code when a recording starts,**
> replacing sequentially said time codes in said auxiliary information outputted from said auxiliary information memorizing section with time codes in series starting from said regeneration value and thereby recording on said recording medium as a new auxiliary information.

The Office Action asserts that Yoshida teaches the last two paragraphs quoted above.

See Office Action, page 15, lines 15-20 (citing rejection of claim 5); page 12, lines 5-10 (asserting "Yoshida et al teaches" language of claim 5, which it appears the Office Action corresponds to the above limitations from claim 6, with citation to Yoshida, col. 6, lines 40 to col. 7, line 2).

Applicants respectfully disagree. Yoshida, col. 6, lines 57-65 states:

> . . . A program "n-1", recorded immediately before the program "n", has a program **time code of 93 at its recording end position.** . . .
> Each of the program time code and **the index time code is initialized at the recording start position, and is incremented as plus value** with elapsing time. Hereinafter, **this region is referred to as a plus region where the program/index time code is recorded as a plus value.** As shown in FIG. 5, the program/index time code is recorded as minus value in a region preceding the recording start position. Hereinafter, this region is referred to as a minus region where the program/index time code is recorded as a minus value.

(emphasis added)

As shown in Yoshida, FIG. 5, the time code for program #N does not continue from the last time code value of "93" for program #N-1 which is recorded immediately before the program #N. Instead, "the index time code is initialized at the recording start position," and starts from zero at

the recording point. Thus, contrary to the basis of rejection set forth in the Office Action, Yoshida does not disclose, or even suggest, "generating a regeneration value obtained from a time code to which one frame time is added to said recorded time code when a recording starts," as recited in claim 6. None of Moe, Kouyama, Naoya, and Toyoshima, either individually or in combination, bridges the above gap between Yoshida and claim 6. Thus, claim 6 is not obvious in view of the cited art.

Further, claim 6 recites, *inter alia*,

> **correcting said regeneration value for an amount of delay corresponding to a storage volume temporarily memorized in said auxiliary information memorizing section and thus obtaining a corrected time code,** and thereafter sequential time codes are generated from said corrected time code though said time code generating section.

By way of illustration, when a corrected time code generated by a time code generating section is output after it is delayed by an auxiliary information memorizing section, the time code corresponds to a time code which has been replaced by a controlling section based on a regenerated value. Because of this, when a mode is changed afterward from a mode using the regenerated value to a mode using the time code generated by the time code generator, it enables maintaining continuity of the time code at a point of such a change. *See, e.g.*, paragraphs [0051]-[0052] of publication corresponding to this application.

The Office Action asserts that Toyoshima teaches the paragraph of claim 6 quoted above. *See* Office Action, page 15, lines 21-25 (citing rejection of claim 5); page 13, lines 7-12 (asserting "Toyoshima et al teaches" language of claim 5, which it appears the Office Action corresponds to the above limitations from claim 6, with citation to Toyoshima, Abstract).

Applicants respectfully disagree. Toyoshima's abstract describes a technique for "correcting the mechanical positional deviation in the time code head purely electrically" by

employing "a delay circuit 33 for time code signal delaying this time code signal for the specified time and a recording head for time code signal recording the time code signal" (from translation of Toyoshima provided via IPDL). However, this does not disclose or suggest "correcting said regeneration value for an amount of delay corresponding to a storage volume temporarily memorized in said auxiliary information memorizing section and thus obtaining a corrected time code," as recited in claim 6. None of Moe, Yoshida, Kouyama, and Naoya, either individually or in combination, bridges the above gap between Toyoshima and claim 6. Thus, in addition to the reasons discussed previously, claim 6 is further not obvious in view of the cited art.

Thus, as the cited art fails to render obvious at least the above limitations, Applicants respectfully request withdrawal of the rejection of claim 6.
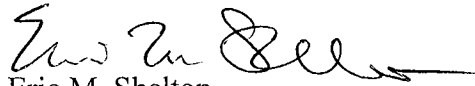

Conclusion

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

Eric M. Shelton
Registration No. 57,630

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 EMS:amz
Facsimile: 202.756.8087
Date: September 9, 2009

Please recognize our Customer No. 53080 as our correspondence address.

DECLARATION

I, the undersigned, of 13-38, Naniwa-cho, Kita-ku, Osaka, Japan, hereby certify that I am well acquainted with the English and Japanese languages, that I am an experienced translator for patent matters, and that claim 6 included in the Response filed on February 13, 2009 in U.S. Patent Application Serial Number 10/525,844 is a true English translation of claim 1 of Japanese Patent No. 3,915,705, which issued on May 16, 2007 from Japanese Patent App. No. 2003-021854, which issued in the Japanese language.

I declare that all statements made herein of my own knowledge are true, that all statements on information and belief are believed to be true, and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Signature:

Toshiaki Kinoshita

Dated: September 7, 2009